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Total Number of Pages in This Submission

5

Application Number

10/721,135

Filing Date

November 25, 2003

First Named Inventor

Robert Kronenberg

Art Unit

3765

Examiner Name

Andrew W. Sutton

Attorney Docket Number

AME00130P00250US

ENCLOSURES (Check all that apply)☐

Fee Transmittal Form

☐

Fee Attached

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Amendment/Reply

☐

After Final

☐

Affidavits/declaration(s)

☐

Extension of Time Request

☐

Express Abandonment Request

☐

Information Disclosure Statement

☐

Certified Copy of Priority Document(s)

☐Reply to Missing Parts/
Incomplete Application☐Reply to Missing Parts
under 37 CFR 1.52 or 1.53☐

Drawing(s)

☐

Licensing-related Papers

☐

Petition

☐Petition to Convert to a
Provisional Application☐

Power of Attorney, Revocation

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Change of Correspondence Address

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Terminal Disclaimer

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After Allowance Communication to TC

☐Appeal Communication to Board
of Appeals and Interferences☒Appeal Communication to TC
(Appeal Notice, Brief, Reply Brief)☐

Proprietary Information

☐

Status Letter

☒Other Enclosure(s) (please identify
below):

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Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name

Wood Phillips Katz Clark & Mortimer

Signature

Printed name

John S. Mortimer

Date

April 16, 2008

Reg. No.

30,407

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of:)	HEADWEAR PIECE WITH
)	SELECTIVELY VIEWABLE
ROBERT KRONENBERGER)	ORNAMENTATION
)	
Ser. No.: 10/721,135)	Group Art Unit: 3765
)	
Filed: 11/25/03)	Examiner: Andrew W. Sutton

APPELLANT'S REPLY BRIEF

Commissioner for Patents
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Sir:

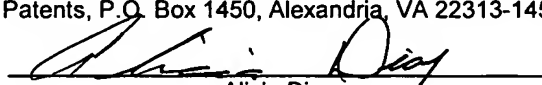
Appellant respectfully submits that the Examiner is relying in his Answer upon an inappropriate interpretation of how descriptive material must function to support patentability.

In paragraph [10] of the Answer ("Response to Argument"), in the first full paragraph, the Examiner states that "...the function of the hat is not changed by adding the printed matter in the specified manner. The hat still function [sic] as a hat and provides information on various sides of the hat as the prior art of record shows".

It is not necessary for added descriptive material to make the hat function as other than a hat to support patentability. *In re Ngai*, cited by the Examiner, supports Appellant's position on this point. While the Federal Circuit in *In re Ngai* did find that the mere addition

37 CFR 1.8
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Alicia Diaz

of an instruction sheet to a product did not support patentability, the Court further explained the significance of added descriptive material, such as Appellant's, relying on the 1983 Federal Circuit case *In re Gulack*. The *Ngai* Court cited the following from *Gulack*: "the critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate". (at page 1338)

The *Ngai* Court noted that a circular band with items printed upon it was well known in the art. (at page 1339). The Court repeated *Gulack*'s findings that the "digits are related to the band in two ways: (1) the band supports the digits; and (2) there is an endless sequence of digits-each digit residing in a unique position with respect to every other digit in an endless loop. Thus the digits exploit the endless nature of the band...although the prior art disclosed a band with printed matter, the Court concluded that the prior art neither 'disclose[d] nor suggest[ed] either feature' of *Gulack*'s invention." (at page 1339)

The *Ngai* Court concluded that printed matter and the circularity of the band were interrelated so as to produce a new and patentable product, useful for "educational and recreational mathematical" purposes. (at page 1339)

Appellant respectfully submits that the claimed headwear piece and printed matter thereon are interrelated in a manner that supported patentability for the *Gulack* band. Appellant's invention exploits the cup or band shape of the crown to strategically place the printed matter so that the headwear piece performs multiple functions. That is, the information is placed on the headwear piece so that it can be used both: a) in a normal manner by players during a game in which the identity of the event is strategically displayed at the front of the headwear piece; and b) as a souvenir wherein the event

participants can be identified on the same headwear piece by viewing the headwear piece from different, non-frontal perspectives.

The information and the shape of the crown on the headwear piece are interrelated so as to produce the multi-functional headwear piece. It is not necessary that the hat function other than as a hat any more than it was necessary for the bands in *Gulack* to function other than as bands with printed matter thereon.

In parallel with *Gulack's* recognition that circular bands with printed matter thereon were known and it was not obvious to strategically place the printed matter on the band to exploit its shape, in the present case, it is known to put information on headwear of the type claimed, yet it is not obvious from the prior art to strategically place the information as claimed to afford a single headwear construction that is multi-functional in nature.

Appellant further respectfully submits that the stated rejections of the claims do not comply with the mandate of the United States Supreme Court in *KSR International Co. v. Teleflex, Inc.* 550 U.S. ____, 82 USPQ 2nd 1385 (2007). The Examiner states in conclusory fashion on page 4 of the Answer that "[i]t would have been obvious to one of ordinary skill in the art to place the information such as sporting event, and participants on a cap in the various positions claimed" without stating any basis for this position.

The court in *KSR*, quoting an earlier Federal Circuit Decision, stated that "[r]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness". (at 1396)

Appellant admits that headwear of the type claimed and headwear of this type with information thereon was well known in the prior art. However, the specific, strategically

placed, information claimed is not taught or made obvious from the prior art. The Examiner has not explained anywhere in the Answer why it would be obvious to one of ordinary skill to place the information differently than in the prior art to arrive at what is claimed by the Appellant to afford the multi-functional product claimed. As such, the rejection should not stand.

It is not clear to the Appellant what the Examiner's argument is with respect to Issue No. 3 on the top of page 7 of the Answer. The only date that is apparent from the website is May 17, 2006; almost three years after the date that the present application was filed. Given that there is no earlier date alleged by the Examiner, the existence of prior art utilizing Appellant's invention suggests copying, which supports patentability, rather than negating it.

In light of the above, reversal of the rejection of claims 1-3 and 5-21 is requested.

Respectfully submitted,

By 
John S. Mortimer, Reg. No. 30,407

WOOD, PHILLIPS, KATZ,
CLARK & MORTIMER
500 W. Madison St., Suite 3800
Chicago, IL 60661
(312) 876-1800

Date: April 9, 2008